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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/629,909	07/31/2000	Douglas B. Quine	F-176	5067
919	7590	01/22/2004	EXAMINER	
PITNEY BOWES INC. 35 WATERVIEW DRIVE P.O. BOX 3000 MSC 26-22 SHELTON, CT 06484-8000			BAYARD, DJENANE M	
			ART UNIT	PAPER NUMBER
			2141	

DATE MAILED: 01/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/629,909

Applicant(s)

QUINE, DOUGLAS B.

Examiner

Djenane M Bayard

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 09 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 17-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This is in response to amendment filed on December 09, 2004 in which claims 17-32 and 34 are pending and claims 33 and 35-36 are canceled. The applicant's arguments have been fully considered but are moot in view of the new ground of rejections. Therefore, this action is made final (see Examiner new rejection).

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 10, 13, 14, 17 and 20-22 are rejected under 35 U.S.C. 102 (e) as being anticipated by U.S. Patent No. 6,438,583 to McDowell et al. in view of U.S. Patent No. 6,075,844 to Goldberg et al

a. In regard to claim 10, McDowell et al teaches a method for transmitting an e-mail message intended for a non-preferred e-mail address to a preferred e-mail address (See col. 1, lines 46-48), the method comprising the steps of: receiving the e-mail message at a second address (See col. 8, line 33); parsing the non-preferred e-mail

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address from the e-mail message at the second address and determining if there is a preferred e-mail address associated with the non-preferred e-mail address; and sending the e-mail message from the second address to the preferred e-mail address (See col. 8 lines 9-10 and lines 34-43). However, McDowell et al fails to teach wherein the e-mail message having been previously rejected at the non-preferred e-mail address and transmitted back to the sender address.

Goldberg et al teaches wherein the e-mail message having been previously rejected at the non-preferred e-mail address and transmitted back to the sender address (See col. 7, lines 30-38).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein the e-mail message having been previously rejected at the non-preferred e-mail address and transmitted back to the sender address as taught by Goldberg et al in the claimed invention of McDowell et al in order for the sender to determine whether the message was correctly sent to the intended recipient (See col. 7, lines 11-12)

b. In regard to claim 13, McDowell et al teaches that the parsing step further comprises the step of comparing the non-preferred e-mail address to a lookup table to determine if the non-preferred e-mail address is contained in the look-up table (See col. 8, lines 9-10).

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c. As per claim 14, McDowell et al teaches a method for transmitting an e-mail message comprising the steps of: receiving an e-mail message at a second address (See col. 1, lines 46-48), the e-mail message including non-preferred e-mail address data associated with a desired recipient; parsing the e-mail message to obtain the non-preferred e-mail address data from the e-mail message; determining a preferred e-mail address from the non-preferred e-mail address data; and sending the e-mail message from the second address to the preferred e-mail address when the preferred e-mail address has been established (See col. 8 lines 9-10 and lines 34-43). However, McDowell et al fails to teach wherein the e-mail message having been previously rejected at the non-preferred e-mail address and transmitted back to the sender address.

Goldberg et al teaches wherein the e-mail message having been previously rejected at the non-preferred e-mail address and transmitted back to the sender address (See col. 7, lines 30-38).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein the e-mail message having been previously rejected at the non-preferred e-mail address and transmitted back to the sender address as taught by Goldberg et al in the claimed invention of McDowell et al in order for the sender to determine whether the message was correctly sent to the intended recipient (See col. 7, lines 11-12)

d. As per claim 17, McDowell et al teaches a method for transmitting an e-mail message that has been sent from a sender address to a previously-known recipient e-mail address and rejected at the previously-known recipient e-mail address, the method comprising the steps of: receiving the rejected e-mail message at a second address; determining a preferred recipient e-mail address from the rejected e-mail message; and sending the e-mail message from the second address to the preferred e-mail address when the preferred e-mail address has been determined (See col. 8 lines 9-10 and lines 34-43). However, McDowell et al fails to teach wherein the e-mail message having been transmitted back to the sender address.

Goldberg et al teaches wherein the e-mail message having been transmitted back to the sender address (See col. 7, lines 30-38).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein the e-mail message having been previously transmitted back to the sender address as taught by Goldberg et al in the claimed invention of McDowell et al in order for the sender to determine whether the message was correctly sent to the intended recipient (See col. 7, lines 11-12)

e. As per claim 20, McDowell et al teaches the step of comparing the previously-known recipient e-mail address to look-up table to determine if the previously-known recipient e-mail address is contained in the look-up table (See col. 8, lines 9-10).

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f. In regard to claim 21, McDowell et al. teaches a method for transmitting an e-mail message that was sent from sender address to a previously-known recipient e-mail address that is associated with a first service provider (See col. 1, lines 50-53), and rejected at the previously-known recipient e-mail address, the method comprising the steps of: receiving the rejected e-mail message at a second address; determining a preferred recipient e-mail address, that is associated with a second service provider from the rejected e-mail message; and sending the e-mail message from the second address to the preferred e-mail address when the preferred e-mail address has been determined (See col. 8, lines 7-11) . However, McDowell et al fails to teach wherein the e-mail message having been transmitted back to the sender address.

Goldberg et al teaches wherein the e-mail message having been transmitted back to the sender address (See col. 7, lines 30-38).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein the e-mail message transmitted back to the sender address as taught by Goldberg et al in the claimed invention of McDowell et al in order for the sender to determine whether the message was correctly sent to the intended recipient (See col. 7, lines 11-12)

g. In regard to claim 22, McDowell et al. teaches a method for transmitting an e-mail message that has been sent from a sender address to a second address, the e-mail message including non-preferred e-mail address data associated with a first service provider and a desired recipient (See col. 1, lines 50-53) comprising the steps of:

receiving the e-mail message at the second address; parsing the e-mail message to obtain the non-preferred e-mail address data from the e-mail message; determining a preferred e-mail address, that is associated with a second service provider, from the non-preferred e-mail address data; and sending the e-mail message from the second address to the preferred e-mail address when the preferred e-mail address has been established (See col. 8, lines 7-11 and lines 34-43) . However, McDowell et al fails to teach wherein the e-mail message having been previously rejected at the non-preferred e-mail address and transmitted back to the sender address.

Goldberg et al teaches wherein the e-mail message having been previously rejected at the non-preferred e-mail address and transmitted back to the sender address (See col. 7, lines 30-38).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein the e-mail message having been previously rejected at the non-preferred e-mail address and transmitted back to the sender address as taught by Goldberg et al in the claimed invention of McDowell et al in order for the sender to determine whether the message was correctly sent to the intended recipient (See col. 7, lines 11-12)

4. Claims 11,15,18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. No. 6,438,583 to McDowell in view of U.S. Patent No. 6014688 to Venkatraman et al.



a. In regard to claims 11,15 and 18, McDowell et al discloses the claimed invention as described above. McDowell et al teaches the step of sending an e-mail message to the sender address from the second address (See col. 12, lines 16-17), however McDowell et al does not explicitly teaches that the e-mail indicates that the e-mail has been sent to the preferred e-mail address.

Venkatraman et al teaches the step of sending an e-mail message to the sender address to indicate that the e-mail has been sent to the preferred e-mail address (See col. 2, lines 35-36).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the step of sending an e-mail message to the sender address from the second address indicating that the e-mail has been sent to the preferred e-mail address as taught by Venkatraman et al in the method of McDowell et al so because the sender of the e-mail message needs to verify that the e-mail message was received by the preferred e-mail address (See col. 1, lines 48-50).

5. Claims 12,16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. No. 6,438,583 to McDowell in view of U.S. Patent No. 6,405,243 B1 to Nielsen.

a. In regard to claims 12, 16, and 19, McDowell et al discloses the claimed invention as described above. McDowell et al teaches the step of sending an e-mail message to the sender address from the second address (See col. 12, lines 16-17), however McDowell fails to disclose that the step of sending an e-mail message to a

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sender address from the second address indicating that the e-mail message was not forwarded to the preferred e-mail address if the preferred e-mail address is not determined.

Nielsen teaches the that the step of sending an e-mail message to a sender address from the second address indicating that the e-mail message was not forwarded to the preferred e-mail address if the preferred e-mail address is not determined (See col. 4, lines 66-67 and col. 5 lines 1-5)

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the step of sending an e-mail message to a sender address from the second address indicating that the e-mail message was not forwarded to the preferred e-mail address if the preferred e-mail address is not determined as taught by Nielsen in the method of McDowell et al in order to update the sender about whether or not the second address has an updated email address for the recipient (See col. 6, lines 41-42).

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Djenane M Bayard whose telephone number is (703) 305-6606. The examiner can normally be reached on 7:00 AM-4:30 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (703) 305-4003. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Djenane Bayard

Patent Examiner

January 8, 2004

  
RUPAL DHARIA  
SUPERVISORY PATENT EXAMINER